

### **REMARKS/ARGUMENT**

I. On page 6 and in paragraph 7 of the September 24, 2003 Office Action (hereinafter "Office Action"), the Examiner indicated that the May 16, 2003, power of attorney had not been accepted because there was no paper filed establishing the right of the assignee, Clear Focus Imaging, Inc., to act in this case. Applicant has filed herein a statement in compliance with Rule 3.73, 37 C.F.R. § 3.73. That statement refers to an Assignment duly recorded at Reel 012435, Frame 0122. The Assignment shows that ownership of the patent was assigned from Creative Minds Foundation, Inc. to Clear Focus Imaging, Inc. Thus, the Assignments on file in this proceeding show an unbroken chain of title from the inventor, Rodney M. Shields, to Clear Focus Imaging, Inc. Accordingly, it is submitted that the May 16, 2003, Power of Attorney complies with all applicable requirements. However, in view of the fact that applicant's attorneys recently changed law firms, another Power of Attorney is being submitted herein.

II. On page 6 and in paragraph 8 of the Office Action, the Examiner objected to this application under Rule 1.172(a), 37 C.F.R. § 1.172(a), as lacking the written consent of all assignees owning an undivided interest in the patent. The Examiner pointed out that the consent of the assignee must be in compliance with that rule and also in compliance with Rule 3.73. Applicant has submitted a statement from Clear Focus Imaging, Inc., the sole owner of the patent, indicating its consent to the reissue proceeding.

Because applicant has obviated the objection contained in paragraph 8 of the Office Action, withdrawal of that objection is respectfully requested.

III. On page 7 and in paragraph 9 of the Office Action, the Examiner indicates that the original patent or an affidavit or declaration as to its loss or inaccessibility must be received before the reissue application can be allowed. Applicant is aware of this requirement and stands ready, willing, and able to comply with it at such time as the reissue application is put into condition for allowance.

IV. On page 7 and in paragraph 10 of the Office Action, the Examiner requested applicant to supply a PTO Form 1449 listing the references printed on the face of U.S. Patent No. 5,609,938 so that such references could be printed on the face of the instant reissue patent. Applicant has submitted a properly filled out Form 1449 in compliance with the Examiner's request.

V. Applicant thanks the Examiner for removal of the objection made in the Office Action mailed on July 24, 2001 based on an allegedly defective reissue declaration. Applicant also thanks the Examiner for withdrawing the rejection under 35 U.S.C. § 102(f) made in the Office Action mailed on July 24, 2001.

VI. On pages 8-12 and in paragraphs 13 and 14 of the Office Action, the Examiner rejected claims 1-5, 7, 9, 11-12, and 22-70 under 35 U.S.C. § 251 as being an improper recapture of claimed subject matter alleged to have been deliberately cancelled in the application for patent upon which the present reissue is based. In making this rejection, the Examiner rejected controlling Supreme Court authority directly on point and instead relied on two cases from a lower court, both of which were misread by the Examiner and neither of which is dispositive of the issue presented or supports the position taken by the Examiner.

The essence of the Examiner's position is the unprecedented adoption of a *per se* rule that would, in the Examiner's opinion, make the reissue statute, Section 251, inapplicable to every case where an applicant seeks to obtain claim coverage surrendered in the application for the original patent. Thus, in the Examiner's opinion, the recapture rule is *per se* applicable to each and every situation where an applicant attempts to obtain claim coverage previously surrendered. Therefore, according to the Examiner's reasoning, even where there was "error" within the meaning of Section 251 and such error was demonstrated in the record, recapture would *ipso facto* be prohibited.

No court has ever upheld such an interpretation of the reissue statute. Indeed, every court has expressly or implicitly rejected such a holding. What is even more remarkable about the Examiner's position is the Examiner's cavalier dismissal of controlling Supreme Court precedent in favor of precedent of a lower court. Neither the U.S. Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office, nor the Examiner, has any authority whatsoever to ignore an applicable case of the U.S. Supreme Court. Indeed, no one in the executive or legislative branches of our government has the authority to ignore controlling Supreme Court precedent.

Applicant relies on the U.S. Supreme Court case of *Morey v. Lockwood*, 75 U.S. 230 (1868). That case is directly on point, is binding on the Examiner, and, therefore, **must** be followed by the Examiner. There can be no deviation from this Supreme Court Case. If the Examiner has any doubt about the applicability of the *Morey* case, he is requested to seek guidance from the PTO's Office of the Solicitor.

In *Morey*, the Supreme Court considered Section 13 of the Patent Act of 1836. That statute authorized reissue of a patent when the patent was inoperative or invalid and there was error that had “arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention.” *Id.* at 240. Insofar as is applicable here, the 1836 reissue statute is the same as 35 U.S.C. § 251 which governs reissue practice today. In Section 251, reissue of a patent is authorized when a patent is “wholly or partly inoperative or invalid” or because the patentee “claimed more or less than he had a right to claim.” In either event, there must be an error, and the error must be “without any deceptive intention.” Thus, insofar as is relevant here, the current statute presents the same legal requirements as the earlier statute. In other words, both statutes require error, and both statutes require the error to be made without any deceptive intention.

In the *Morey* case, the error that was present was the same type of error that is present in this case. In *Morey*, the Commissioner of Patents required the claim to be amended and narrowed in view of a product that was in the marketplace and described in a printed publication. To obviate the rejection and get around the prior art, the applicant amended and narrowed the claim. The patent issued with the narrower claim. Subsequent to issuance of the patent, it was determined that the Commissioner of Patents had been in error with respect to the content of the alleged anticipatory prior art and, therefore, the applicant had been in error in acquiescing to the position of the Commissioner of Patents. The U.S. Supreme Court held that the error was an error without deceptive intent and that the applicant was entitled to obtain reissuance of the original patent with the previously surrendered claim.

The type of error made in the *Morey* case is identical to the type of error made in the application that led to the original patent in this case. In this case, the U.S. Patent and Trademark Office made an error, as will be demonstrated below, in construing the disclosure of U.S. Patent No. 4,673,609 (hereinafter “Hill” or “the Hill patent”) and using the misconstrued disclosure to reject applicant’s claims. Applicant here, as in *Morey*, acquiesced to the error of the Commissioner of Patents. Thus, as in *Morey* where the applicant was permitted to obtain coverage which had earlier been surrendered, this applicant seeks no less.

The Examiner cavalierly rejects this Supreme Court case without so much as discussing it—simply stating that the “position of the Examiner is that current law is governed by *In re Clement*,” 131 F.3d 1464 (Fed. Cir. 1997). The perfunctory disregard of controlling Supreme Court precedent is impermissible. Nowhere does the Examiner state why the

Supreme Court case is being disregarded, and nowhere does the Examiner state why current law is governed by the decision of a lower court or even how current law could conceivably be governed by the decision of a lower court. The position of the Examiner is even more mysterious because the *In re Clement* case does not support the position of the Examiner and is not inconsistent with the *Morey* case.

In *Clement*, the applicant made a number of amendments to the claims in the application to get around a reference and to overcome the Examiner's rejection over another reference. A reissue application was filed wherein the applicant sought to recapture subject matter that he had surrendered to overcome the prior art. The reissue declaration stated that the applicant failed to understand the claims and that his attorney failed to appreciate the scope of his invention. The Examiner had found the reissue declaration defective because it failed to mention the error or to explain sufficiently how the errors arose. Under the circumstances presented in *Clement*, the Federal Circuit applied the recapture rule. However, and of extreme significance, the Federal Circuit indicated that "the recapture rule does not apply in the absence of evidence that the applicant's amendment was 'an admission that the scope of that claim was not in fact patentable.'" *Id.* at 1464. The court additionally stated that a court "'may [not must] draw inferences from changes in claim scope when other reliable evidence of the patentee's intent is not available.'" *Id.* (Emphasis added.) However, the court went on to say that the deliberate cancellation or amendment of a claim in an effort to overcome a reference does not *ipso facto* require application of the recapture rule, but only suggests that the applicant admits that the scope of the claim before cancellation or amendment was unpatentable. *Id.* Significantly, the court indicated that even this was "**not dispositive** because other evidence in the prosecution history may indicate the contrary." *Id.* (Emphasis added.)

Thus, it is clear that the Federal Circuit did not adopt a *per se* rule on recapture in the *Clement* case. It is also clear that the Federal Circuit did not purport to "overrule" or distinguish *Morey*—it did not mention or discuss *Morey*—or otherwise indicate that it was no longer applicable to the issue at hand. It can be assumed that if the Federal Circuit had intended to disagree with *Morey*, it would have discussed the issue, the case and the holding. It did none of these things. As explained on pages 31 and 32 of the amendment mailed by applicant on March 22, 2000, *Morey*, is still good law under the 1952 reissue statute, Section 251, was cited with approval by the Court of Claims, a predecessor court of the Federal

Circuit which adopted Court of Claims precedent as its own, and has been cited with approval in a different context by the Federal Circuit itself.

*Clement* is simply a restatement of the Federal Circuit's longstanding opinions on this issue. For example, in *Seattle Box Company, Inc. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826 (Fed. Cir. 1984), the Federal Circuit stated:

Industrial argues that the PTO incorrectly allowed the broadened reissue claims with a scope equivalent to the scope of the preamended claims in the original patent application. The recapture rule does not apply here, however, because there is no evidence that Seattle Box's amendment of its originally filed claim was in any sense an admission that the scope of that claim was not in fact patentable. (Citations omitted.)

That same year, the Federal Circuit reiterated its holding that the deliberate cancellation or amendment of a claim to obtain issuance of a patent does not require the *per se* application of the recapture rule. In that case, the Federal Circuit specifically stated:

[T]he CCPA has repeatedly held that the deliberate cancellation of claims *may* constitute error, if it occurs without deceptive intent.

*Ball Corp. v. United States*, 729 F.2d 1429, 1435 (Fed. Cir. 1984) (cited by the Examiner on pages 8-9 of the Office Action). It is important to note that the Federal Circuit used the word *may*, put it in italics, and **did not hold** that the deliberate cancellation or amendment of claims can never constitute error.

The Federal Circuit's opinion in *In re Wilder*, 736 F.2d 1516 (Fed. Cir. 1984), is especially significant in this proceeding. In that case, the reissue declaration alleged error based on the attorney's failure to appreciate the full scope of the invention. As the Court of Appeals for the Federal Circuit stated, that "error arose because the attorney assumed the presence of features in the prior art that were not there." The PTO had concluded that this error was not the type of error contemplated by the reissue statute. *Id.* at 1519. The Federal Circuit squarely rejected the position of the PTO, noting that the "error provision of 35 U.S.C. § 251 is to be liberally construed to permit correction of defects...and also noting that "an attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *Id.* at 1519.

The foregoing cases establish the following points of law:

1. There is absolutely no *per se* rule that bars the recapture of subject matter irrespective of the nature of the error.
2. Recapture of previously surrendered subject matter is authorized and is within the scope of the reissue statute when, as required by the statute, there was error without deceptive intent.
3. An attorney's mistake in understanding the prior art and/or the Patent Office's mistake in understanding the prior art are precisely the kinds of errors without deceptive intent that are specifically contemplated by the reissue statute.

Applicant's reissue declaration established error without deceptive intention of the type shown in the foregoing cases. Thus, the recapture doctrine is inapplicable, and the Examiner's adoption of a *per se* recapture rule operative in every circumstance where recapture is sought is not authorized by the statute and is specifically prohibited by all controlling authority. Applicant respectfully requests the Examiner to withdraw his rejection based on the recapture rule.

**VII.** On page 12 and in paragraph 15 of the Office Action, the Examiner rejected claim 5 under 35 U.S.C. § 112, first paragraph, because it allegedly contains subject matter which was not described in the specification. According to the Examiner, it was not clear that the Markush group was supported in the original specification. Support for the Markush group is contained in the following columns and lines of U.S. Patent No. 5,609,938, which is referred to for ease of reference: col. 3, lines. 20-21, 34-37, and 58-61; col. 4, lines, 3-4, 22-24, and 47-48; col. 6, lines, 9-11; col. 7, lines. 7-9, and 52-53; col. 8, lines 55-56 and 67-col. 9, line 1; and col. 9, lines 26-28, 30-31, and 42-43. Applicant requests the Examiner to withdraw the rejection of claim 5 under Section 112.

**VIII.** Applicant thanks the Examiner for withdrawal of the rejection of claims 2 and 3 in paragraph 16 of the Office Action in view of applicant's amendments to those claims filed March 27, 2000.

**IX.** On page 12 and in paragraph 17 of the Office Action, the Examiner rejected claims 1, 2-5, 7, 9, and 11-12 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. According to the Examiner, it was not clear whether there was antecedent basis for "said transparent panel" in amended claim 1. Applicant has amended claim 1 and claim 7, both of which contained the reference to a transparent panel. Applicant's amendments

delete the word "transparent." Accordingly, applicant requests the Examiner to withdraw the rejection of these claims under 35 U.S.C. § 112, second paragraph.

X. On pages 13-15 and in paragraph 19 of the Office Action, the Examiner rejects claims 1, 5, 7, 9, 22, 24-30, 32, 34-41, and 67 under 35 U.S.C. § 103 as being unpatentable over Hill. The heart of the Examiner's rejection, and indeed the heart of every prior art rejection that the Examiner makes wherein Hill is relied upon, is column 13, lines 37-49 and claim 15 of the Reexamination Certificate. The Examiner's reliance on claim 15 of the Reexamination Certificate is easily addressed.

Simply stated, the Examiner's reliance on claim 15 of the Re-examination Certificate is improper and impermissible. Claim 15 of the Reexamination Certificate was entirely added in the reexamination proceeding. It formed no part whatsoever of the original disclosure and the original claims of the Hill patent application. As the Examiner knows, in this case, only Hill's original disclosure, whether that disclosure be present in the specification, the original claims or the drawings, can be used to support the prior art rejection which the Examiner is making. Claim 15 of the Reexamination Certificate is not prior art against applicant's reissue application.

Having removed claim 15 of the Reexamination Certificate as a basis for the Section 103 rejections, the Examiner is left only with column 13, lines 37-49, which provides as follows:

Alternatively, suitable grades of sheet or film material can be punched, burnt, laser cut or otherwise cut normally to achieve a perforated membrane of a grid, net or filigree type of silhouette pattern, the holes of whatever shape forming the transparent areas. The holes may be formed after printing or otherwise applying the required design "blocked out" or the required design may be produced after the holes have been formed, for example, by spraying using appropriate stencils or masking to control the areas of application. Such patterned perforated sheets or membranes may then be formed within, attached to, or be independent of the transparent sheet or film materials.

There has been much discussion of Hill's disclosure in this proceeding, and in the reissue and reexamination proceedings involving the Hill patent itself. Suffice it to say, the PTO originally believed that claim 15 was not supported by the disclosure of the Hill patent. For whatever reason, the PTO changed its mind and made a determination that the original Hill disclosure supported the claim. Applicant herein does not intend to rehash all of the

arguments that it has made in this proceeding (the arguments are all incorporated in this paper by reference as if set forth in full herein). Rather, applicant intends to set the record straight, focus on the very narrow issue presented and demonstrate that the Examiner's reliance on Hill as prior art is misplaced.

Prior to discussing the Hill disclosure, it is important to point out what Hill has said about his disclosure in other contexts and in other forums. Those statements help demonstrate that Hill does not disclose multiple, perforated layers.

In seeking reissue of his United Kingdom patent (GB 2,165,292), the counterpart to the U.S. patent, Hill's representative argued to the United Kingdom Patent Office that his transparent panel was perforated, not because it had actual holes, but because blobs of ink were present on the transparent panel, and the spaces between them could be considered perforated. The United Kingdom Patent Office rejected this "virtual perforation" argument and said that it stretched the disclosure of the patent beyond all limits. The decision of the United Kingdom Patent Office to refuse reissue with claims to a perforated structure because those claims represented new matter is binding on the PTO, is persuasive and acts also as an admission because it involves the same applicant, the same issue, the same disclosure and, insofar as is relevant here, essentially the same claims. These conclusions follow directly from the doctrine of collateral estoppel or issue preclusion. At least two cases have held in patent cases that issue preclusion forecloses a party from relitigating a factual issue lost in a foreign forum between the same two parties where the issue is the same, the issue was actually decided, determination of the issue was necessary to the final decision and the losing party had an opportunity to litigate that issue fully and fairly. *Oneac Corp. v. Rachem Corp.*, 20 F. Supp. 1233, 1242-43 (N.D. Ill. 1998) (United Kingdom factual findings have preclusive effect in a patent case); *Northlake Marketing Supply, Inc. v. Glaverbel, S.A.*, 986 F. Supp. 471, 475 (N.D. Ill. 1997) (Belgian determination that certain patents disclosed the same invention as other patents was given preclusive effect).

The March 3, 2000 decision of the United Kingdom Patent Office was attached as Exhibit 1 to applicant's Amendment mailed on March 22, 2000. Pages 14-16 and paragraphs 38-42 of that decision relate to the issue at hand.

Hill did not argue "virtual perforations" in his U.S. reexamination proceeding for the Hill patent. Instead, Hill argued as follows:



All panels according to the present invention comprise a "sheet of light permeable material" (Claim 1), which may be transparent or translucent sheet or film or a perforated material, which may be attached to or independent of a transparent or translucent sheet or film (Col. 1, lines 10-23; Col. 13, lines 37-49).

Hill Reexamination Proceeding, Amendment and Response, mailed July 22, 1994, at page 18.

Discussing Amended Claim 15, Hill stated:

Amended independent Claim 15 is based on granted Claim 1 and granted Claim 15 and one of the assemblies for producing a panel according to the present invention, using cut material (Col. 13, lines 27-49). This section of the present patent describes many methods of using cut material, one being illustrated in Fig. 25, which falls within granted Claim 28. The description of Figure 25 also discloses general features concerning the use of cut material (Col. 19, line 64 to Col. 20, line 28).

A perforated material, being a material with holes formed within it, is referred to in the present patent as a perforated sheet, a perforated membrane or a film material that is punched, burnt, laser cut or otherwise cut (Col. 13, lines 39-47). A perforated material forms a light permeable material, whether that material is transparent, translucent or opaque, the holes always forming light permeable areas. Separately, a perforated material can form a silhouette pattern, being an opaque material in the unperforated areas (Col. 3, line 14) which may then be applied to a transparent or translucent sheet or film material, which it subdivides into a plurality of transparent or translucent areas (Col. 3, lines 14-17), providing a grid, net or filigree type of silhouette pattern (Col. 13, lines 39 and 40). Even with transparent perforated film, the perforations normally form the plurality of transparent areas of the silhouette pattern in the finished product, as the opaque design and/or silhouette pattern can only be applied to the film material and not the holes in between, which ensures compliance with granted Claim 15.

Amended Claim 15 is restricted to perforated material in the form of a perforated self-adhesive assembly, comprising a perforated material carrying at least one design, a layer of self-adhesive and a removable, protective film to the self-adhesive, all of which are perforated, whether the self-adhesive assembly is perforated before or after application of a design. The section Col. 13, lines 27-49, encompasses many options for the use of perforated material and a perforated self-adhesive assembly is one of those options.

*Id.* at 38-39. As the foregoing excerpts demonstrate, Hill repeatedly relied on Col. 13, lines 27-49 as support for his perforated structure claimed in reexamination Claim 15.

Hill, however, actually went further. According to Hill, the subject matter disclosed in Col. 13 was unobvious to one of ordinary skill in the art at the time of the invention. According to Hill:

There is no reference to the use of such perforated self-adhesive assemblies in the art of record. The use of perforated self-adhesive assemblies would not have been obvious to one skilled in the art at the time of the present invention.

Additionally a printer or other manufacturer would have normally only perforated the film material to which the design is applied, not the whole self-adhesive assembly, as only the perforated face material carrying a design is required to be applied to a window or other sheet of transparent material, the protective film (typically a "non-stick" coated paper or plastic) being removed prior to application. Therefore, there is no reason the protective film needs to be perforated, incurring additional cost and difficulty of perforation.

*Id.* at 39-40. Hill presented other indicia of non-obviousness by pointing out unexpected benefits of a perforated assembly. *Id.* at 40.

In arguing non-obviousness, Hill could have gone even further by saying that a perforated protective film is the antithesis of a protective layer. One does not perforate a layer that is designed to protect what is under it. Indeed, the Hill patent disclosure explicitly references the fact that the purpose of the protective layer is to protect the pattern and design applied to a panel as stated by Hill in his patent:

The pattern and design applied to a panel can be protected in a number of different ways. For example, as shown in Fig. 7, the pattern 14 can be covered by a transparent sheet 12 bonded to sheet 10 by adhesive 16. In Fig. 8, the pattern 14 is protected by sheet 12 bonded directly to sheet 10 and provided with recesses 18 in which the pattern 14 is received. In Fig. 9, the pattern 14 is located in recesses in a colorless sheet 12. The panel of Fig. 10 has its pattern 14 protected by a thin protective cover layer 22 bonded to sheet 10 by adhesive 16. Fig. 11 shows the pattern 14 on the inner surface of a sheet 10 which is part of a double glazing or like assembly having a second sheet 12 spaced from sheet 10 and defining an air gap 24.

Col. 7, lines 52-65.

Hill's reading of the cryptic language in column 13 of his patent to encompass a perforated, multi-layer assembly is inconsistent with his argument that such an assembly is not obvious. Because the column 13 language does not explicitly describe a perforated, multi-layer structure and because no such structure is shown in any of the drawings of the Hill patent, Hill is only left with the argument that his specification—to one of ordinary skill in the art—discloses the multi-layer perforated structure. *Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858 (Fed. Cir. 1993).

The Federal Circuit decision in *Turbocare Division of Demag Delaval Turbomachinery Corporation v. General Electric Company*, 264 F.3d 1111 (Fed. Cir. 2001), is directly in point. The patent at issue in that case was completely lacking in any description of an embodiment in which the spring was located between the casing shoulders and the inner surface of the outer ring portion of the ring segment, as required by claim 2 of the patent. *Id.* at 1116 and 1119. Such an embodiment may have been obvious from a vague reference to a “spring...located adjacent to said rings.” *Id.* at 1119. In holding that this was not enough to satisfy the written description requirement, the Federal Circuit stated:

While the meaning of terms, phrases, or diagrams in a disclosure is to be explained or interpreted from the vantage point of one skilled in the art, all the limitations must appear in the specification. The question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification. Rather, a prior application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought. *Id.*

How could the multi-layered structure of Hill claim 15 be unobvious to one of ordinary skill in the art--as argued by Hill--and yet, at the same time, the cryptic column 13 disclosure is said to disclose the claim 15 structure to one of ordinary skill in the art? Before the Hill patent is applied as prior art, this question should be answered. In answering this question, this Examiner should consider that another Examiner at one time did not read the Hill patent as disclosing a multi-layer, perforated disclosure and, therefore, in the reissue proceeding, rejected claim 15 as being drawn to new matter. *See Hill Reissue Proceeding*, Paper No. 12, mailed June 1, 1998, at pages 3-4.

The concept of “perforation” actually disclosed in the Hill patent is a far cry from the structure claimed in claim 15 of the reexamined and reissued Hill patent. The word “perforated” (or its tenses) is mentioned a total of five times in the entire Hill patent

disclosure. Three of those five times are in connection with a stencil, Col. 9, line 35; Col. 11, lines 42-52, which from the context of the patent disclosure, and as determined by the United Kingdom Patent Office, are not supportive of a perforated panel. Instead, the stencil is used to make the product, but is removed and is not part of the final product. *See e.g.* Decision of the United Kingdom Patent Office, page 15, ¶ 40.

The remaining two times that the word “perforated” is mentioned is contained in the paragraph set forth in Col. 13., lines 27-49. Accordingly, if there is any support whatsoever for the disclosure or any claim of the Hill patent to read on a perforated multi-layered structure, it would have to be contained in column 13. A comparison of column 13, lines 27-49 with a portion of applicant’s independent claim 1 demonstrates that there is no such support. Applicant’s independent claim 1 provides, in part:

wherein said panel, said adhering means, and said protective liner are simultaneously perforated to define a plurality of through holes arranged in a staggered array, the adhered together perforated said transparent panel and perforated said protective liner forming said perforated panel assembly;

Column 13, lines 27-49 of the Hill patent provides as follows:

8. The silhouette pattern and design may be formed by a cut film, normally applied from a carrier layer to a sheet substrate by self adhesive. The required pattern and design may be printed “blocked out” on the film or may comprise a laminate of cut layers to produce a similar effect, prior to die cutting and removal of the areas required to be transparent. The film material can be reeled and can be cut and the unwanted areas removed mechanically, reel to reel, normally with a silhouette pattern of continuous straight or curved lines. Alternatively, suitable grades of sheet or film material can be punched, burnt, laser cut or otherwise cut normally to achieve a perforated membrane of a grid, net or filigree type of silhouette pattern, the holes of whatever shape forming the transparent areas. The holes may be formed after printing or otherwise applying the required design “blocked out” or the required design may be produced after the holes have been formed, for example, by spraying using appropriate stencils or masking to control the areas of application. Such patterned perforated sheets or membranes may then be formed within, attached to, or be independent of the transparent sheet or film materials

It is important to note that this passage from column 13 is directed specifically to one of eight complicated methods of making a panel with a “differential design” (col. 10, lines 27-29), which is defined as a “design on one side which when viewed from one side is different than

any design on the other side and can not be seen when viewed from the other side” (*id.* at lines 20-26)..

Nowhere in column 13 is there any disclosure of applicant’s claimed structure comprising three perforated layers: a panel, an adhesive layer and a protective layer, all of which are required to be perforated. There simply is no such meaning that can be derived from the Hill disclosure. Similarly, not a single drawing of the original Hill patent application shows such a perforated structure. Especially significant is the lack of any perforations shown anywhere in Hill Figure 25. Figure 25 is the drawing that is said to illustrate “method 8”, quoted above, of Hill. Hill at Col. 19, line 64-Col. 20, line 19. Method 8 is the disclosure that embraces Hill’s column 13 language—the alleged support for the multi-layer perforated structure. *Id.* at Col. 13, lines 27-49. Thus, at most, Hill discloses a structure having only one perforated layer.

The Examiner’s statement on page 15 of the Office Action that “perforation in one step of all layers that require through vision would also have been obvious in view of the teaching to perforate before coating of the image area” is unsupported. This statement, of course, directly contradicts the position of Hill who, as previously discussed, argued to the Patent Office that perforating the structure was not obvious. Indeed, there is no suggestion in Hill to perforate the entire structure and, as pointed out previously, perforation of a protective layer is not obvious because it is the antithesis of a protective layer.

Equally important, the relative absence of the use of the word “perforated” and the total absence of any disclosure of the size, number, percent of open area due to the perforations, and patterning of the perforations is readily understandable. In contrast to the five occurrences of the word “perforated,” Hill’s disclosure uses the word “transparent” 74 times, the word “translucent” 12 times, the word “colorless” 4 times, and the “light colored” panel 2 times. The prolific use of these words is because Hill’s panel assembly relies on a transparent or at least translucent panel for the see through feature. Applicant relies, instead, on an assembly that is perforated all the way through and employs an opaque coating. U.S. Patent No. 5,609,938, Col. 3, lines 17-33. The holes allow viewing through the panels. *Id.* at Abstract, lines 3-4.

In Hill’s “Field of the Invention”, the invention is described in terms of “transparent or translucent panels” Col. 1, lines 5-7. Hill’s “Summary of the Invention” describes two aspects of the invention. One aspect is a “colorless or light colored” sheet of material. The

other is a panel of "transparent or translucent" material. Col. 1, lines 65-67; Col. 2, lines 22-23. Finally, Hill states:

The invention has so far been principally described in relation to transparent materials. However, the invention is also applicable to translucent materials....

Col. 5, lines 62-64. The transparent or translucent nature of the panel is repeatedly pointed out throughout the "Detailed Description of the Invention."

If the Examiner persists in his rejection of the claims based on the Hill disclosure, he is requested to specifically identify by column and line number in the disclosure of the Hill patent, the language that supports a structure comprising each of the three perforated layers recited in applicant's independent claim 1. Because the Examiner will be unable to provide such support, he is respectfully requested to withdraw each and every rejection based on the Hill patent.

XI. On pages 15-16 and paragraph 20 of the Office Action, the Examiner rejects claims 3, 4, 23, 31-33, 42-66 and 69-70 under 35 U.S.C. § 103 as being unpatentable over the Hill patent as previously applied in view of Frey, United States Patent No. 1,199,882. Applicant also traverses this rejection. Applicant's previous discussion of Hill is applicable to this rejection. In the opinion of the Examiner, it would have been obvious to anyone of ordinary skill in the art to use transparent areas or holes in the panel of Hill in a staggered pattern because Frey teaches this pattern as a design choice for transparent areas in a viewing panel. The Examiner also stated that a staggered pattern in the flexible embodiments of Hill would inherently give tearing resistance and that the Frey pattern is presumed to have the open area percentage and hole size range of the instant claims since it allows enough light through the panel to allow viewing through the panel from the backside as does the pattern of the instant claims.

The Examiner's reliance on Frey is misplaced. Frey discloses a glass mirror that has no perforations whatsoever. Nor does Frey share the other structural features recited in applicant's claims. There is absolutely no teaching or suggestion in either reference to combine one reference with the other reference. It appears that the Examiner has made use of hindsight to combine two references. This is a violation of all controlling case authority.

The fact that it is possible to find two separate and distinct disclosures which, using hindsight and the claimed invention as a road map, are combined to allegedly construct the claimed invention does not render the claimed invention obvious unless the references

contain a teaching or suggestion to combine the two disclosures. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997); *In re Grabiak*, 769 F.2d (Fed. Cir. 870 (Fed. Cir. 1985). If the law were otherwise, virtually every claimed invention—most of which are a combination of old elements—could be rendered obvious by simply combining disclosures which disclosed the old elements until each element of the claimed invention was disclosed by the combination of references.

The Examiner is requested to withdraw the rejection of applicant's claims based on the combination of the Hill and Frey patents.

**XII.** On pages 16-17 and paragraph 21 of the Office Action, the Examiner rejected claims 11 and 12 under 35 U.S.C. § 103 as being unpatentable over the Hill patent as previously applied and further in view of Mallik (United States Patent No. 5,128,779) and Rosenthal (United States Patent No. 4,034,555). Applicant also traverses this rejection. Applicant's previous discussion of the Hill patent is relevant to this rejection. According to the Examiner, it would have been obvious to use either the hologram disclosed in Mallik or the lenticular lens disclosed in Rosenthal to enhance the image of Hill. These references are not properly combinable with Hill.

Mallik discloses a hologram to use as an authenticating or security technique to prevent alteration or counterfeiting. Alternatively, Mallik teaches that his hologram can be used as a see through window in packaging. In neither case is the hologram used on a panel such as is disclosed by Hill. Moreover, there is no teaching in Hill or Mallik as to how or where the Mallik hologram would be constructed on the Hill panel.

Rosenthal teaches the use of a lenticular lens sheet so that when viewed from one angle, a first composite image is seen. When viewed from another angle, a second composite image is seen. In neither reference is there any teaching as to how or where the Rosenthal lens sheet would be constructed on the Hill panel.

Equally important, neither Hill, Mallik nor Rosenthal contain any teaching or suggestion that one reference can be combined with another. The Examiner has again used hindsight to construct the claimed invention by selecting elements from isolated references and combining them, using the claimed invention as a road map to reject the claims. This is improper.

The Examiner is requested to withdraw the rejection of applicant's claims over the Hill patent in view of the Mallik and Rosenthal patents.

**XIII.** On pages 17 and 18 and in paragraph 22 of the Office Action, the Examiner rejected claims 2 and 68 under 35 U.S.C. § 103 as being unpatentable over Hill as previously applied in view of Bogner (DE 28 38 028). Applicant also traverses this rejection. Applicant's previous discussion of Hill is relevant to this rejection. The Examiner erroneously states that Hill teaches perforated image, adhesive and liner layers which may be flexible and printed after perforation. However, assuming *arguendo* that this is correct, according to the Examiner, Bogner, teaches applying a non-perforated backing layer to a permeable fabric layer in order to allow the fabric layer to be better handled by printing machines. Therefore, in the Examiner's opinion, it would have been obvious to one of ordinary skill in the art to use a non-perforated backing layer on the perforated image and liner layers of Hill in order to allow handling of the perforated combination during further printing because of the teachings of Bogner.

Again, there is no suggestion or teaching in either of these references that suggests combining the references. Indeed, to suggest that Hill would take his allegedly entirely perforated multi-layer structure and attach a non-perforated backing layer to affect further printing is unsupported. Even if it were supported, there is no teaching in either reference as to which side of Hill's alleged multi-layer structure the backing layer would be attached. Moreover, why would one attach a backing layer to the protective layer—i.e. why wouldn't the alleged perforated protective layer of Hill be sufficient to function in place of the backing layer taught by Bogner? Indeed, in Japanese Utility Model 51-86049 (Giken), cited on the face of the Hill reissue patent, a non-perforated backing layer is adhered to a pressure sensitive adhesive layer.

The structures and materials disclosed in the Hill and Bogner patents are dissimilar and non-analogous. This is another example of the Examiner's improper use of hindsight to pick and choose among several references in an effort to come up with the limitations in the claims. This is improper. The Examiner is requested to withdraw the rejection of claims 2 and 68 over the Hill patent in view of the Bogner patent.



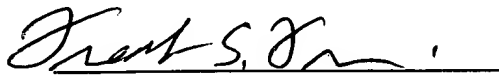
### CONCLUSION

In view of the above amendments and remarks, applicant respectfully submits that the application is in condition for allowance. Prompt examination and allowance are respectfully requested.

Should the Examiner believe that anything further is desired in order to place the application in even better condition for allowance, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

Date: November 24, 2003



Frederick S. Frei  
Registration No. 27,105  
**Andrews Kurth LLP**  
1701 Pennsylvania Ave, N.W.  
Suite 300  
Washington, DC 20006  
Tel. (202) 662-3049  
Fax (202) 662-2739